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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,477	10/24/2003	Abhijeet Gole	5693P030	1909
48102 7590 07/08/2008 NETWORK APPLIANCE/BSITZ BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER NGUYEN, DUSTIN				
ART UNIT		PAPER NUMBER		
2154				
MAIL DATE		DELIVERY MODE		
07/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/692,477

Applicant(s)

GOLE ET AL.

Examiner

DUSTIN NGUYEN

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 27-47 are presented for examination.

Claim Objections

2. Claims 29, 36, 43 are objected to because of the following informalities: “the destination IP” should be corrected as “the destination IP address”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 27, 31, 34, 38, 41 and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 27, 31, 34, 38, 41 and 45:

- ☐ according to predefined priorities for the plurality of subfields (claims 27, 34 and 41)
- ☐ according to predefined priorities for a plurality of partitions (claims 31, 38 and 45).

Applicant indicates that the new added limitations are supported in specification, paragraphs 0041-0047. At best, these paragraphs of the specification provide information on several fields, i.e. Port ID, Port Name, etc..., and failover partition. It is unclear how the quoted paragraphs of the present specification can be equated with the applicant's claimed interpretation of "according to predefined priorities for a plurality of subfields or according to predefined priorities for a plurality of partitions".

Therefore, claims 27, 31, 34, 38, 41 and 45 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

(2) Claims 27, 31, 34, 38, 41 and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 27, 31, 34, 38, 41 and 45:

- ☐ according to predefined priorities for the plurality of subfields (claims 27, 34 and 41)
- ☐ according to predefined priorities for a plurality of partitions (claims 31, 38 and 45).

Undue experimentation would be needed to **search a plurality of subfields ... according to predefined priorities for the plurality of subfields or to search the plurality of values for ... according to predefined priorities for a plurality of partitions.**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 31-33, 38-40, 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. The following terms lack antecedent basis:

- | | | | |
|------|-----------------------------|---|-------------------------------|
| I. | the FC name server database | - | claims 31, 38, 45 |
| II. | the destination IP | - | claims 31-33, 38-40, 45-47 |
| III. | the FC network address | - | claims 31, 33, 38, 40, 45, 46 |

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 27-29, 34-36, and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Latif et al. [US Patent No 2003/0091037].

8. As per claim 27, Latif discloses the invention as claimed including a machine-implemented method for a storage system to transmit an IP packet over a Fibre Channel (FC) network [i.e. transferring data between IP devices and SCSI or Fibre Channel devices] [Abstract; Figure 2; and paragraphs 0007 and 0038], the method comprising:

accessing an FC name server database in response to a request for a connection over the FC network with a destination IP address [i.e. IP/Fibre Channel address conversion table on the name server] [Figures 12C and 12D; and paragraphs 0066, 0073, 0074];

discovering an FC network address corresponding to the destination IP address by searching a plurality of subfields in the FC name server database according to predefined priorities for the plurality of subfields [i.e. perform address translation between IP and Fibre Channel address domain] [Figure 6A; and paragraphs 0043-0057, 0065];

establishing the connection over the FC network using the discovered FC network address [Figure 3; and paragraphs 0037 and 0041];

transmitting the IP packet using the established connection over the FC network [i.e. transferring data between IP and FC devices] [Abstract; and paragraphs 0006 and 0007].

9. As per claim 28, Latif discloses wherein the predefined priorities are determined based on the positions of the plurality of subfields [Figure 6A; and paragraphs 0043-0057 and 0074].

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10. As per claim 29, Latif discloses wherein discovering the FC network address corresponding to the destination IP address comprises: obtaining from an FC name server a plurality of values for a field in the FC name server database, wherein the field contains the plurality of subfields; searching the plurality of values for the field based on the predefined priorities until finding a match with the destination IP; and obtaining from the FC name server the FC network address corresponding to a value for the field, which has the match with the destination IP [i.e. convert IP and FC addresses from the address tables] [Figures 12C and 12D; and paragraphs 0065, 0066, 0073 and 0074].

11. As per claims 34-36, they are rejected for similar reasons as stated above in claims 27-29.

12. As per claims 41-43, they are rejected for similar reasons as stated above in claims 27-29.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 30, 31, 33, 37, 38, 40, 44, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latif et al. [US Patent Application No 2003/0091037], in view of Zhu et al. [US Patent No 6,353,612].

15. As per claim 30, Latif does not specifically disclose wherein the plurality of subfields are positioned in a symbolic node name field of the FC name server database. Zhu discloses wherein the plurality of subfields are positioned in a symbolic node name field of the FC name server database [Figure 3; col 2, lines 34-37; col 5, lines 37-43; and col 9, lines 51-56]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Latif and Zhu because the teaching of Zhu on querying or probing for registration information would enable to avoid requiring any end-devices from having to initiate login with fabric [Zhu, col 2, lines 13-24].

16. As per claim 31, it is rejected for similar reasons as stated above in claims 27, 29 and 30. Furthermore, Zhu discloses querying an FC name server for the FC network to retrieve a symbolic node name field from the FC name server database [i.e. retrieve symbolic name] [col 9, lines 51-54; and col 10, lines 3-9]; receiving from the FC name server a plurality of values for the symbolic node name field [i.e. descriptive name and vendor] [col 9, lines 54-58].

17. As per claim 33, Zhu discloses wherein obtaining from the FC name server the FC network address comprises querying the FC name server to retrieve the FC network address corresponding to a value for the symbolic node name field, which has the match with the destination IP [i.e. query the SNS and obtain the necessary FCP-based information for communication] [col 8, lines 56-65].

18. As per claims 37, 38 and 40, they are rejected for similar reasons as stated above in claims 30, 31 and 33.

19. As per claims 44, 45, 47, they are rejected for similar reasons as stated above in claims 30, 31 and 33.

20. Claims 32, 39 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latif et al. [US Patent Application No 2003/0091037], in view of Zhu et al. [US Patent No 6,353,612], and further in view of Foster et al. [US Patent No 7,042,877].

21. As per claim 32, Latif and Zhu do not specifically disclose wherein the symbolic node name field includes two partitions, and searching the plurality of values for the symbolic node name fields comprises searching values for a first partition of the two partitions for the destination IP address; and searching values for a second partition of the two partitions if no match has been found with the destination IP in the first partition. Foster discloses wherein the symbolic node name field includes two partitions, and searching the plurality of values for the symbolic node name fields comprises searching values for a first partition of the two partitions for the destination IP address; and searching values for a second partition of the two partitions if no match has been found with the destination IP in the first partition [col 10, lines 13-31]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Latif, Zhu and Foster because the teaching of Foster would enable to

provide load balancing between multiple alternative destinations on one or more of the networks and provide content-based routing of data communication in order to identify appropriate destinations and/or transmission routes [Foster, col 4, lines 55-63].

22. As per claims 39 and 46, they are rejected for similar reasons as stated above in claim 32.

23. Applicant's arguments with respect to claims 27-47 have been considered but are moot in view of the new ground(s) of rejection.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2154